

FEB-25-2005 16:06

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**FAX**

Date February 25, 2005  
To Tarah K. Hardy Ludlow  
Of U.S. Trademark Office - Law Office 110  
Fax 571-273-9110  
From Kevin G. Smith, Esq.  
Subject HOTELS.COM (Serial No. 78/277681)  
Our Ref S8232  
Pages 4  
(Including cover sheet)

Please call attention to problems with this transmission by return fax or telephone. Thank you.

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Dear Ms. Hardy Ludlow

Please see attached Request for Reconsideration of Final Refusal issued 11/22/04.

Very truly yours,

A handwritten signature in black ink, appearing to read 'Kevin G. Smith', written over a horizontal line.

Kevin G. Smith

11/22/04  
FEB-25-2005 16:06

SUGHRUE MION PLLC

202 331 4308 P.02/04

Attorney Dkt. No. S-8232

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the matter of

Hotels.com, L.P.

U.S. Serial No.: 78/277,681

Filed: July 23, 2003

Mark: HOTELS.COM

Trademark Examining Attorney

Tarah K. Hardy Ludlow

Law Office 110

BOX RESPONSES NO FEE  
Commissioner for Trademarks  
P. O. Box 1451  
Alexandria, Virginia 22313-1451

**REQUEST FOR RECONSIDERATION AFTER FINAL REFUSAL**

Applicant's counsel acknowledges receipt of the Final Office Action dated November 22, 2004. After careful consideration of its contents and correspondence with Applicant, counsel responds as follows.

**AMENDMENT**

Please enter the following statement to the application:

APPLICANT IS THE OWNER OF U.S. REGISTRATION NOS.  
2,918,738 AND 2,793,744.

**REMARKS**

In an non-final Office Action dated August 11, 2004, the Examining Attorney continued refusal under Section 2(e)(1) as it relates to the services in Class 43. The basis of the refusal indicates that in the Examiner's opinion, applicant's Section 2(f) evidence at that time was insufficient to demonstrate acquired distinctiveness. The Examiner recognized the significant high sales of applicant's services and the significant advertising expenditures associated therewith that were previously made of record. However, the Examining Attorney indicated that standing alone, such evidence merely demonstrated success of applicant's services, but not that relevant consumers had come to view the proposed mark as a source indicator for applicant's services. In addition, the Examining Attorney raised an issue with respect to the specimens submitted to support the application.

Responsive to the refusal, on October 28, 2004, applicant submitted its Amendment and Remarks. The Examining Attorney was provided with the evidence requested, specifically that consumers had indeed come to recognize applicant's mark as a source origin indicator, therefore satisfying, in applicant's opinion, the request for evidence. The October 28 Amendment and Remarks submitted 64 Declarations, 18 of which were signed by individuals involved in the travel reservation and transportation and travel agency business, along with 46 Declarations from consumers. All 64 Declarations stated that each Affiant believed and recognized applicant's mark HOTELS.COM as a trademark of applicant. Applicant submits that the combined Section 2(f) evidence of record after the submission of the October 28 Amendment and Remarks was sufficient to overcome the refusal and place the instant application in condition for allowance under Trademark Act Section 2(f).

Since the submission of applicant's Amendment and Remarks of October 28, applicant's co-pending application, Serial No. 76/976907, has matured to Registration No. 2,918,738. Applicant believes that the claim of ownership for this registration should be made of record. Similarly, undersigned counsel assumed prosecution of this application after its initial submission and has since noted that applicant's other co-pending registration, No. 2,793,744 for the mark 1 800 USA HOTELS.COM was not previously claimed.

By the above Amendment, applicant has submitted addition 2(f) evidence, specifically the ownership of two prior registrations incorporating the term at issue in the instant application. Applicant submits that with the claim of ownership of its prior registrations, the record clearly supports publication under Section 2(f). Applicant requests that the final refusal be reconsidered and withdrawn, and the instant application allowed for publication under Section 2(f) with the claim of ownership of the prior registrations noted in the above Amendment.

Applicant has noted the deadline for timely filing an Appeal of the final refusal. Once the above Amendments are entered and the Examining Attorney has reviewed this Request for Reconsideration, Applicant will timely file its Notice of Appeal to perfect its position as stated in prior submissions. It is hopeful, however, that the Appeal will be moot in view of the evidence of record and this submission.

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SUGHRUE MION PLLC

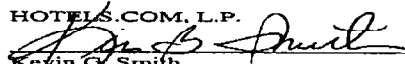
202 331 4308 P.04/04

If further Amendment or clarification is required, the Examining Attorney is encouraged to contact undersigned counsel by telephone at the number listed below.

Respectfully submitted,

HOTELS.COM, L.P.

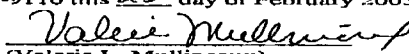
By:

  
Kevin G. Smith  
Attorney for Applicant  
SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3202  
Telephone: (202) 293-7060

Dated: February 25, 2005.

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing REQUEST FOR RECONSIDERATION AFTER FINAL REFUSAL, is being facsimile transmitted to the U.S. Patent and Trademark Office, properly addressed to the attention of Tarah K. Hardy Ludlow in Law Office 110 at 571-273-9110 this 25 day of February 2005.

  
(Valerie L. Mullineaux)